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09/941,467	08/29/2001	Sterling Mortensen	10004428-1	6476

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EXAMINER
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UNITED STATES PATENT AND TRADEMARK OFFICE

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Technology Center 2100

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/941,467
Filing Date: August 29, 2001
Appellant(s): MORTENSEN, STERLING

Scott A. Lund
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 6, 2006 appealing from the Office action

mailed March 9, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,886,036   Santamaki et al.   Nov. 2, 1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

FINAL ACTION

1. Applicant's arguments, see pages 7-8 of applicant's remarks, filed 12/21/2005, with respect to the rejection(s) of claim(s) 1-30 under 35 USC 102(e) have been fully considered and are not persuasive. Therefore, the rejection has been maintained, this rejection has been made final.

2. Applicant is required to update the status (pending, allowed, etc.) of all parent priority applications in the first line of the specification. The status of all citations of US filed applications in the specification should also be updated where appropriate.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-4, 9-10, 12-20, 25, and 27-30 are rejected under 35 U.S.C. 102(e) as being unpatentable over Santamaki et al. (hereinafter Santamaki). US 6.886,036.

5.   As per claim 1, Santamaki teaches a method of distributing an electronic document to a mobile computing device including a display (Col. 4. lines 55-61), the method comprising the steps of:

translating a data file of the electronic document into a translated data file for the electronic document, including identifying a print format of the electronic document (Col. 5, line 55 - Col. 6, line 12);

displaying the electronic document on the display of the mobile computing device, including converting the translated data file for the electronic document into display instructions for the electronic document and displaying the electronic document based on the display instructions in accordance with the print format (Col. 5. line 55 - Col. 6. line 12; Col. 13. line 64 - Col. 14. line 3; Col. 12. lines 57-63);

wherein translating the data file includes translating the data file of the electronic document into print instructions for the electronic document (Col. 5, lines 57-64, where the conversion of doc files to e-book files is done by the emulation software, the doc files are printed on to the server 30 via print instructions from the clients), transferring the print instructions to a printer (Col. 5, lines 25-36, where the documents are printed on to the a e-book server 30 acting as a printer), and converting the print instructions into the translated data file for the electronic document at the printer (Col. 5, lines 55 – Col. 6, lines 6, where the conversion takes place at the e-book server 30, font, size and color capabilities, i.e. representations of the documents will present itself in the printed document on the e-book server).

6.   As per claim 2, Santamaki teaches the method of claim 1, wherein identifying the

print format of the electronic document includes identifying at least one of a page margin. a

page layout, a paper orientation, and a paper size for the electronic document (Col. 6. lines

1-7).

7.   As per claim 3. Santamaki teaches the method of claim 1, wherein the step of

translating the data file includes translating the data file of the electronic document into an

exchange file format (Col. 5. lines 53-63).

8.   As per claim 4. Santamaki teaches the method of claim 1, wherein the step of

translating the data file includes translating the data file of the electronic document into the

translated data file for tile electronic document via a printer driver (Col. 5. lines 55-67; Col. 7.

lines 55-67).

9.   As per claims 9-10, the claims are rejected for the same reasons as rejection to claims

4-5 above respectively.

10.   As per claim 12. Santamaki teaches the method of claim 1, wherein the step of

transferring the translated data file includes transferring the translated data file for the;

electronic document to mobile computing device front the printer (Col. 5. lines 10-15: Col. 6.

lines 5-15).

11.   As per claim 13. Santamaki teaches the method of claim 12, further comprising the step of:

linking the mobile computing device (Fig 1, item 50) and the printer (Fig 1, item 30) via a communication link (Col. 4, lines 45-55; Fig 1, item 40), wherein the step of transferring the translated data file includes transferring the translated data file for the electronic document to the mobile completing device from the printer via the communication link (Col. 5. lines 10-20).

12.   As per claim 14. Santamaki teaches the method of claim 1, further comprising the step of:

identifying an address of the mobile computing device. wherein the step of transferring the translated data file includes transferring the translated data file for the electronic document to the address of the mobile computing device (Col. 15. lines 1-14; Col. 6. lines 10-15).

13.   As per claim 15. Santamaki teaches the method of claim 1, wherein the step of transferring the translated data file includes transferring the translated data file for the electronic document to the mobile computing device via a computer (computer 10, Fig 1) associated with the mobile computing device (Col. 5, lines 10-15).

14.   As per claim 16. Santamaki teaches the method of claim 15, wherein the step of transferring the translated data file includes transferring the translated data file for the

electronic document to the computer (computer 10, Fig 1), and further comprising the step of

synchronizing the mobile computing device with the computer (computer 10, Fig 1),

including transferring the translated data file for the electronic document to the mobile

computing device from the computer (Col. 5, lines 10-15. lines 55-67).

15.   As per claim 17-18, the claims are rejected for the same reasons as rejection to claim 1

above.

16.   As per claim 19-20, the claims are rejected for the same reasons as rejection to claim

2-3 above respectively.

17.   As per claims 25, the claims are rejected for the same reasons as rejection to claim 4

above.

18.   As per claim 27. Santamaki teaches the first processor is adapted to transfer the print

instructions for the electronic document to the second processor via the communication link

(Col. 5, lines 25-37, lines 55-67) and the second processor is adapted to transfer the translated

data file for the electronic document to the mobile computing device via the communication

link (Col. 8. lines 24-30).

19.   As per claims 28-29, claims 28-29 are rejected for the same reasons as rejection to

claims 14 and 15 above respectively.

20.   As per claim 30, claims 30 is rejected for the same reasons as rejection to claim 16

above.

        (10) Response to Argument

I.   <u>Santamaki's e-book server corresponds to Applicant's claimed printer</u>

        Applicant argues in substance the Santamaki does not disclose translating a data file

of the electronic document into print instructions for the electronic document, transferring

the print instructions to a printer, and converting the print instructions into a translated data

file for the electronic document at the printer. <u>Applicant's Appeal Brief</u>, pg. 6, ¶4. Applicant

asserts that Santamaki discloses converting a document at a desktop PC or the e-book server

and does not disclose converting the document at a printer. <u>See</u> <u>Id</u>. Applicant's argument is

not persuasive for the following reasons.

        With respect to the e-book sever, Santamaki discloses that the e-book server emulates

a network printer [column 2 «lines 35-39» | column 4 «lines 38-47»]. The term "emulate", as

interpreted by one skilled in the networking arts, is defined as a process by which a computer

acts as if it is another kind of computer or terminal. This interpretation is supported by

Santamaki's disclosure. For example, Santamaki discloses: "[t]he emulation software may

preferably be installed at the e-book server 30 to emulate the e-book server 30 as an ordinary

"printer" in a private network 20" [column 4 «lines 56-58»].

        In the context of Santamaki's invention, printing an electronic document means

translating the electronic document into print instructions [column 2 «lines 50-63»],

transferring the print instructions to a printer (Santamaki's e-book server emulating a

printer) [column 2 «lines 35-39»] and converting the received instructions into a data file for the electronic document at the printer [column 5 «line 62» to column 6 «line 12»].

Thus, Santamaki's e-book server represents a printer within the context of Santamaki's invention. Santamaki's e-book server is analogous to Applicant's claimed printer.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

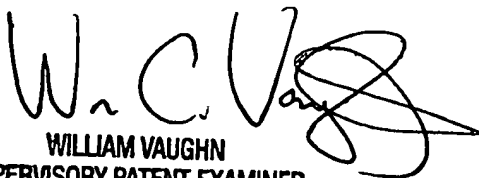Respectfully submitted,

Dohm Chankong

August 11, 2006

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